

REMARKS

Applicants have amended the specification to add the continuity data that was requested by the Examiner.

Claims 1-4 are amended herein. New claim 11 is added. Basis for new claim 11 can be found in the application as filed, for example, page 45 through page 52.

No new matter has been introduced.

Reconsideration of the application is respectfully requested in view of the remarks set forth below.

Rejection under 35 U.S.C. § 102(b)

The Examiner rejects the instant claims under 35 U.S.C. 102(b) as being anticipated by PCT publication no. WO 00/35886 (the '886 publication). The Examiner alleges that the compound 2-(2-hydroxy-biphenyl-3-yl)3H-benzoimidazole-5-carboxamidine (CAS RN 277311-06-5; disclosed at page 179, lines 28-29 of the '886 publication) anticipates the instant claims. Applicants respectfully disagree.

Instant claim 1 is directed to compounds of Formula I, where X^1 is N; X^2 , X^3 , and X^4 are each -CR⁵-, where R⁵ is hydrogen; R^x is hydroxy at the 2'-position; R^z is at the 5'-position; R¹, R², and R^y are each hydrogen; and R³ is -CONR⁷R⁸, -(alkylene)-CONR⁹R¹⁰ or -CONHSO₂R¹¹.

None of the compounds disclosed in the '886 publication is a compound of Formula I as defined in instant claim 1, where X¹ is N, R^x is hydroxy at the 2'-position, R^z is at the 5'-position, and R³ is -CONR⁷R⁸, -(alkylene)-CONR⁹R¹⁰ or -CONHSO₂R¹¹. Furthermore, the compound 2-(2-hydroxy-biphenyl-3-yl)3H-benzoimidazole-5-carboxamidine, which the Examiner alleges anticipates the instant claims, does not fall within the scope of instant claim 1. Thus, the '886 publication does not anticipate instant claim 1. Instant claims 2, 3, 4, and 11, which depend on claim 1, are not anticipated by the '886 publication. Therefore, withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

Rejection under 35 U.S.C. § 103(a)

The Examiner rejects claims 1-4 under 35 U.S.C. 103(a) as unpatentable over PCT publication no. WO 00/35886 (the '886 publication). The Examiner states that the '886 publication discloses the compound 2-(2-hydroxy-biphenyl-3-yl)3H-benzoimidazole-5-carboxamidine (CAS RN

277311-06-5; disclosed at page 179, lines 28-29 of the ‘886 publication) and thus alleges that to those skilled in the chemical art, one homologue with R³ as -H (prior art compound) is not such an advance over adjacent members of the series with R³ as alkyl, which the Examiner describes as the situation for the instant claims. Applicants respectfully disagree that the instant claims are obvious over the ‘886 publication.

Instant claim 1 is directed to compounds of Formula I, where X¹ is N; X², X³, and X⁴ are each -CR⁵-, where R⁵ is hydrogen; R^x is hydroxy at the 2'-position; R^z is at the 5'-position; and R³ is -CONR⁷R⁸, -(alkylene)-CONR⁹R¹⁰ or -CONHSO₂R¹¹. None of the compounds in the ‘886 publication is a compound of Formula I in instant claim 1, where X¹ is N and R^x is hydroxy at the 2'-position. Furthermore, none of the compounds in the ‘886 publication is a compound of Formula I in instant claim 1, where X¹ is N, R^x is hydroxy at the 2'-position, R^z is at the 5'-position, and R³ is -CONR⁷R⁸, -(alkylene)-CONR⁹R¹⁰ or -CONHSO₂R¹¹. Furthermore, the ‘886 publication does not teach or suggest compounds of Formula I, where X¹ is N; X², X³, and X⁴ are each -CR⁵-, where R⁵ is hydrogen; R^x is hydroxy at the 2'-position; R^z is at the 5'-position; and R³ is -CONR⁷R⁸, -(alkylene)-CONR⁹R¹⁰ or -CONHSO₂R¹¹.

In essence, the ‘886 publication provides non-anticipatory structures/formulas that have a large number of potential sites for substitution. As presented above, the cited reference lacks multiple features of the compounds claimed in the instant application. To explore the immense potential chemical space with just this reference and end up with the claimed compounds would be a prohibitively large experimental effort. The cited references does not cite a particular feature as being critical for activity, and as such one of skill in the art would have no basis for arriving at the claimed compounds. Even with the benefit of hindsight, it is difficult to imagine that one of skill in the art could piece together the vast number of permutations to form the claimed compounds. Therefore, withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

Double Patenting

The Examiner rejects instant claims 1-4 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. patent no. 6,867,200 (‘200 patent). The ‘200 patent is a national stage entry of PCT/US99/30302 (WO 00/35886; ‘886 publication). As stated above, instant claims 1-4 and new claim 11 are not anticipated by or obvious over the ‘886 publication. Thus, instant claims 1-4 and new claim 11 are not anticipated by or obvious over the ‘200 patent. Applicants do not agree with the Examiner that a terminal disclaimer is required for the

instant application because the claims of the instant application do not overlap with the claims of the '200 patent. Therefore, withdrawal of the rejection on the grounds of nonstatutory obviousness-type double patenting is respectfully requested.

CONCLUSION

Based on the amendments and arguments presented herein, Applicants respectfully request that the rejections be withdrawn and the claims be allowed. Applicants respectfully solicit the Examiner to expedite prosecution of this patent application to issuance. Should the Examiner have any questions, the Examiner is encouraged to telephone the undersigned.

The Commissioner is hereby authorized to charge any additional fees that may be required, or credit any overpayment to Deposit Account No. 23-2415 (Attorney Docket No. 25922-760.201).

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI

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By: 

Michael Hostetler, Ph.D., J.D.
Attorney for Applicants
Registration No. 47,664

650 Page Mill Road
Palo Alto, CA 94304
Direct Dial: (858) 350-2306
Customer No. 021971